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May 29, 2009

John W. Cabeca
Director, Technology Center 2800
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Re: U.S. Patent Appln. No. 09/382,702
For: POWER SUPPLY FOR LIGHT EMITTING DIODE ARRAY
Attorney Docket No.: 9100.2881 REI

Dear Mr. Cabeca:

I am writing concerning the prosecution of the above-identified application. Normally, I would not write the Director of the Technology Center about a prosecution matter, but I believe that the examiner's handling of this case represents an egregious violation of Patent and Trademark Office examination practice that you should be aware of.

Please be assured that I have discussed the points raised in this letter both with Examiner Bao Vu and with his Supervisory Primary Examiner Akm Ullah. Both believe that proper PTO procedure has been followed. Please also be assured that I am not writing to request that you intervene in the case substantively. I realize that the examiner is entitled to his opinion that the claims are not patentable, and I have filed an appeal brief contesting the pending rejection.

I am writing because in 35 years of prosecuting literally thousands of patent applications, there are few cases I have handled in which both an examiner and his supervisor have so flagrantly flouted the rules governing how the PTO is supposed to handle patent applications. The examiner has repeatedly refused to explain how he applied the prior art to the claims in the application and to consider a declaration submitted under 37 C.F.R. § 1.132. Mr. Ullah refused to intervene and suggested that the applicant's only recourse is an appeal.

A brief chronology is perhaps the best way to explain why I am writing:

Apr. 13, 2007: Preliminary Amendment following a request for continued examination presents reissue claims very similar to those on appeal. The Preliminary Amendment is accompanied by a Declaration of Peter A. Hochstein, submitted pursuant to 37 C.F.R. § 1.132 (the Hochstein Declaration).

July 16, 2007: Office action rejects the reissue claims, referring to a "claimed clamp circuit's 'voltage sensing means'" and a "control load means," limitations in long-since canceled original patent claim 6. The reissue claims under examination have no "clamp circuit," no "voltage sensing means," and no "control load means." The office action also refers to language concerning patent claim 6 in the court's opinion in *Relume Corp. v. Dialight Corp.*, 63 F.Supp.2d 788 (E.D. Mich. 1999), *aff'd*, 4 Fed. Appx. 893 (Fed. Cir. 2001), which had held patent claim 6 invalid. The office action does not mention the Hochstein Declaration.

Dec. 12, 2007: Amendment places the reissue claims in their present form (that is, as appealed). The Amendment requests the examiner to treat the claim language actually presented, notes the differences between the claims presented and patent claim 6, and requests that he consider the Hochstein Declaration.

Feb. 11, 2008: Notice of Allowance does not mention the Hochstein Declaration, but includes the following examiner's statement of reasons for allowance:

> None of the prior art alone or in combination discloses based on applicant's arguments in the response "a conflict monitor compatibility circuit achieves this advantage over Hildebrand (prior art) by using a transistor "biased as a switch having an essentially **nonconductive** condition whenever the electrical **input voltage is at or above the operating range lower limit voltage**." Hildebrand's MOSFET Q3, likened by the Examiner to the applicant's transistor biased as a switch **is conductive at and above the lower limit of a voltage operating range sufficient to activate LEDs**. (emphasis in original)

This statement reflects the applicant's patentability arguments in the Amendment of December 12, 2007.

July 25, 2008: PTO withdraws application from issue after issue fee is paid.

Aug. 12, 2008: Office action rejects patent claims 7-23 (they had been allowed earlier in the prosecution) over new prior art. The reissue claims, which have not been amended since their allowance, are rejected under reasoning nearly identical to that in the pre-allowance office action. (The discussion of the Hildebrand reference is taken *verbatim* from the office action of July 16, 2007.) As in the previous office action, the examiner refers to a "[nonexistent] claimed clamp circuit's [nonexistent] 'voltage sensing means'" and a "[nonexistent] control load means." Still the examiner does not mention the Hochstein Declaration. Nor does he explain why he

changed his position as expressed in his statement of reasons for allowance.

Sept 12, 2008: Response to Office Action cancels patent claims 7-23; no changes are made to the reissue claims. The applicant again requests that the examiner treat the actual claim language and discuss the Hochstein Declaration.

Jan. 22, 2009: Office action still does not treat the claim actual claim language, again referring to a "claimed clamp circuit's 'voltage sensing means'" and a "control load means." The examiner also refers again to language concerning canceled patent claim 6 in *Relume Corp. v. Dialight Corp.* He still does not mention the Hochstein Declaration.

Since the Preliminary Amendment of April 13, 2007, the applicant has placed significant reliance on its claimed "conflict monitor compatibility circuit" with a low impedance load in series with a transistor biased as a switch. The transistor has "an essentially nonconductive condition" and "an essentially conductive condition" at certain voltages. These circuit elements and the manner in which they operate are, the applicant believes, not shown in the prior art. There is no "clamp circuit," "voltage sensing means," or "control load means" in any of the rejected claims.

Initially, it seems too basic to require citation to authority that a rejection should deal with an applicant's actual claim language. The M.P.E.P. repeatedly exhorts examiners to treat an applicant's claims. Two examples are found in M.P.E.P. § 2106:

> The claims define the property rights provided by a patent, and thus require careful scrutiny. The goal of claim analysis is to identify the boundaries of the protection sought by the applicant and to understand how the claims relate to and define what the applicant has indicated is the invention. USPTO personnel must first determine the scope of a claim by thoroughly analyzing the language of the claim before determining if the claim complies with each statutory requirement for patentability. See *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) ("[T]he name of the game is the claim.").
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> * * * *
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> The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined.

M.P.E.P. § 2106 II.C., 8th ed., Rev. 6, Sept. 2007, at 2100-6, 2100-7 (emphasis in original).

Except for his statement of reasons for allowance, the examiner has ignored the actual claim language. As a result, the applicant has been forced to appeal claims that have, in fact, really never been rejected, at least based on their actual language.

Then there is the Hochstein Declaration, which presents substantive technical evidence, including test results, supporting patentability of the claimed invention. Since its presentation on

April 13, 1997, four subsequent office actions (including a notice of allowance) never mentioned this declaration or the evidence it presents. The examiner and his supervisor believe this to be an acceptable manner of examining a patent application.

For my part, I have twice requested that the examiner consider the Hochstein Declaration, citing M.P.E.P. sections that compel him to do so. For example, the Amendment of December 12, 2007 (which resulted in allowance), included the following request;

> The applicant notes that the Office Action [of July 16, 2007] fails to discuss the Hochstein Declaration. According to the Manual of Patent Examining Procedure, 8th ed., Rev. 6, Sept. 2007 ("MPEP"):
>
> > Evidence traversing rejections, when timely presented, must be considered by the examiner whenever present. All entered affidavits, declarations, and other evidence traversing rejections are acknowledged and commented upon by the examiner in the next succeeding action.
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> MPEP § 716.01(B), at 700-289.
>
> The instruction to consider evidence of nonobviousness submitted in a timely declaration is repeated at MPEP § 716.01(a), at 700-289 ("Objective Evidence Must Be Considered When Timely Presented"). That consideration must be in accordance with the following principles:
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> > When an applicant timely submits evidence traversing a rejection, the examiner must reconsider the patentability of the claimed invention. The ultimate determination of patentability must be based on consideration of the entire record, with due consideration to the persuasiveness of any argument and any secondary evidence to the contrary.
>
> MPEP § 617.01(d), at 700-291. See also In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) ("If rebuttal evidence of adequate weight is produced, the holding of *prima facie* obviousness, being but a legal inference from previously uncontradicted evidence, is dissipated.").
>
> In preparing the current Office Action, dated July 16, 2007, the Examiner appears not to have considered the Hochstein Declaration, which was previously and timely submitted with the Preliminary Amendment dated April 13, 2007. Accordingly, if the Examiner still believes that the present application is not allowable upon reconsideration of the patentability of the applicant's invention in light of this Amendment and the previously submitted Hochstein Declaration, the applicant respectfully submits that it would be premature to make the next rejection final.

Amendment of December 12, 2007, at 21-22 (emphasis in original).

This request was repeated in the Response to Office Action of September 12, 2008. It was again communicated by me to the examiner, and this time also to his supervisor, in separate

telephone conversations subsequent to the last office action of January 22, 2009. Both indicated that they were satisfied that the application had been handled properly and that the applicant's recourse was an appeal.

The examiner's failure to treat the applicant's actual claim language and the Hochstein Declaration is serious. The examiner may be planning to address the claim language and the Hochstein Declaration in his examiner's answer in the appeal. That would mean that the applicant will have been deprived of the opportunity to amend the claims to address the examiner's reading of the actual claim language, or to counter any objections to the Hochstein Declaration with additional evidence, or both. And reopening prosecution to treat the actual claim language and the Hochstein Declaration will not repair the damage already caused by the examiner, especially the loss of term of any reissue patent that results from the present application occasioned by unnecessary additional prosecution.

At this stage I believe it would be appropriate to assign this application to a different examiner with a different supervisor. In view of my repeated requests to have the current examiner follow PTO examining practice, and his supervisor's acquiescence in his refusal to do so, I believe that it would be futile simply to again ask them to do what they have steadfastly refused to do in the past. Both the pending appeal, and any continuing prosecution, would be better handled by a different examiner who reports to a different supervisor.

In closing, I would like to reiterate that I am not writing to request that you intervene in this case to second guess the examiner's rejections. However, as a customer of the PTO, and a registered practitioner of long standing, I believe I have a right and an obligation to report to PTO management the gross mishandling of the examination of this application.

If you wish to discuss this case, I am available by telephone, or I am willing to travel to the PTO to meet with you in person.

Sincerely,

David M. Quinlan
Applicant's Attorney
Registration No. 26,641

cc: Margaret A. Focarino, Acting Commissioner for Patents
Akm Ullah, Supervisory Primary Examiner, T.C. Art Unit 2838
Bao Q. Vu, Primary Examiner, T.C. Art Unit 2838